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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,382

08/28/2006

Glenn D. Prestwich

24U03.1-071

4731

23506 7590 06/15/2009  
GARDNER GROFF GREENWALD & VILLANUEVA. PC  
2018 POWERS FERRY ROAD  
SUITE 800  
ATLANTA, GA 30339

EXAMINER

LOEWE, SUN JAE Y

ART UNIT

PAPER NUMBER

1626

NOTIFICATION DATE

DELIVERY MODE

06/15/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@gardnergroff.com  
mkandcer@gardnergroff.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/552,382	PRESTWICH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	SUN JAE Y. LOEWE	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-9,11,13-15,17-21,73-75 and 77-88 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,6,7,9,11,13-15,17-21,73-75 and 77-88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. Claims 1-4, 6-9, 11, 13-15, 17-21, 73-75 and 77-88 are pending in the instant application. Claims 3, 4, 6, 7, 9, 11, 13-15, 17-21, 73-73 and 77-88 remain withdrawn.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 12, 2009 has been entered.

***Response to Amendment***

3. The amendments to the claims filed on March 12, 2009 have been fully considered. However, they are not persuasive in overcoming the outstanding grounds of rejection. Below are responses to Applicant's remarks.

4. The reference of Xu et al. was published on October 25, 2002. The priority date of the instant application is April 9, 2004 which is more than one year after the publication of Xu et al. Therefore, the reference of Xu et al. still applies as prior art. Therefore, the 35 USC 102 and 35 USC 103 rejections are maintained. The reference of Xu et al. currently applies as 35 USC 102(b) art. See corrected ground of rejection below, Section 12.

Note: The provisional application US 60/462,095 does not adequately provide support for the instantly claimed genus. The instant genus of compounds wherein the variables are defined, for example, as

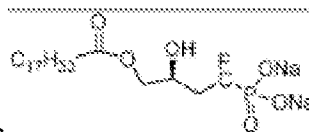
$X^1$ ,  $X^2$ ,  $Y^1$ , and  $Y^2$  comprises, independently, hydrogen, fluorine, a hydroxyl group, a branched or straight chain  $C_1$  to  $C_{25}$  alkyl group,  $OR^2$ ,  $OCH_2CH_2OR^2$ ,  $OC(O)R^2$ , or  $NC(O)R^2$ ;

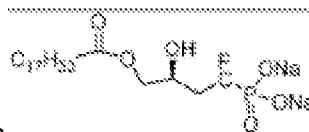
is broader than the genus disclosed in US 60/462,095 which defines the same variables as

$X^1$ ,  $X^2$ ,  $Y^1$ , and  $Y^2$  are, independently, hydrogen, fluorine, a hydroxyl group,  $OR^2$ ,  $OCH_2CH_2OR^2$ ,  $OC(O)R^2$ , or  $NC(O)R^2$ ;

5. Applicant's amendment to the specification filed on September 22, 2008 introduces new matter. See new ground of objection below, Section 8.

6. New grounds of rejection set forth herein, Sections 9-11.



7. Note: Applicant has elected the species of  in view of the amendment to the specification. It is noted that the alkyl portion of the elected compound C<sub>17</sub>H<sub>33</sub> is unsaturated based on the number of hydrogen atoms. The instant specification

The term "alkyl group" as used herein is a branched or unbranched saturated hydrocarbon group of 1 to 25 carbon atoms, such as methyl, ethyl, *n*-propyl, .

Therefore, the elected species does not fit into any of the generic claims. Appropriate clarification and correction is requested.

### *Specification*

8. The amendment filed September 22, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows.

Table 1 was presented with corrected species, for example, compounds on the second through eighth rows. There is not support for the amended species in the originally filed disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 1, 2 and 8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims refer to the term “comprises.” This term is open ended, therefore it is unclear what the scope is for the compounds claimed.

10. Claim 1, 2 and 8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims refer to “R1 form a cyclic or heterocyclic group.” The instant specification does not define "cyclic", therefore it is unclear what the distinction is between cyclic and heterocyclic. Appropriate clarification and correction requested.

11. Claim 1, 2 and 8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims refer to the term “substantially.” The instant specification does not define precisely the term substantially. See for example, disclosure below:

The term "substantially" with respect to the stereochemistry at carbon a refers to greater than 95%, greater than 97%, greater than 98%, greater than 99%, greater than 99.5%, or 100% of one enantiomer with respect to the other enantiomer. The terms "R" and "S" with respect to the stereochemistry at carbon a are also referred to in the art as "D" and "L," respectively.

. It is unclear from the disclosure the metes and bounds of the claims. Appropriate correction and clarification is requested.

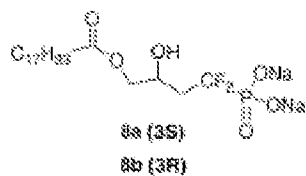
### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 2 and 8 rejected under 35 U.S.C. 102(b) as being anticipated by Xu et al. The references teaches the following:



which is encompassed by the instant claims.

### *Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUN JAE Y. LOEWE whose telephone number is (571)272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sun Jae Y. Loewe/  
6-6-2009